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2166

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/882,416	Applicant(s) BEEK ET AL.	
	Examiner Khanh B. Pham	Art Unit 2166	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-59 is/are rejected.
- 7) ☒ Claim(s) 29, 42-46 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed June 9, 2005 has been entered. Claims 1-59 have been amended. Claims 1-59 are pending in this Office Action.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-59 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-59 direct to “a digital file”, which is a data structure ; it is not tangibly embodied, for example, on a computer readable medium so as to be executable. It also appears to be non-functional descriptive material.

Claims 1-59 are directed to “a digital file”, and the bodies of the claims recite only nonfunctional descriptive material. Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material”. In this context, “functional descriptive material” consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of “data structure” is “a physical or logical relationship among data elements, designed to support specific data manipulation functions.” The New IEEE Standard Dictionary of Electrical and Electronic Terms 308 (5th ed. 1993).). “Nonfunctional descriptive material” includes, but is not limited to music, literary works, and compilation or **mere**

arrangement of data. Both type of “descriptive material” are nonstatutory when claimed as descriptive material per se. Warmerdam, 33 F. 3d at 1360, 31 USPQ2d at 1759.

When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Claims 1-59 are directed to nonfunctional descriptive material per se and therefore nonstatutory.

Claim Objections

3. **Claims 29, 42-46** are objected to because of the following informalities:

- **Claim 29**, misspelled word “anner” at line 3 should be changed to “manner”.
- **Claims 42-46** recite the limitation “the digital file description scheme of claim...” in line 1. There is insufficient antecedent basis for this limitation in the claims.

For purposes of examination, the examiner presumes the limitation should read: “the digital file of claim...”

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2166

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 41-42, 46** are rejected under 35 U.S.C. 102(b) as being anticipated by Pereira ("MPEG-7: a Standard for Describing Audiovisual Information", 1999), hereinafter "Pereira".

As per claim 41, Pereira teaches a digital file (page 6/4, 3rd paragraph) comprising:

- "a MPEG-7 description scheme that includes the identification of the format of at least one of audio and visual media" at page 6/1, last paragraph;
- "said description scheme including data for rendering said at least one of said audio and visual media" at page 6/2, 2nd paragraph (i.e., "reproduction data");
- "said at least one of said audio and visual media being contained within said description scheme" at page 6/2, 2nd paragraph. (Pereira teaches that "MPEG-7 descriptions may be physically co-located with the 'reproduction data', in the same data stream")

As per claim 42, Pereira teaches the digital file of claim 41 wherein "said description scheme is InlineMedia".

(The examiner relies on Applicant's specification for the definition of "InlineMedia", "that permits the identification of

the format of the media stream" and "enables the description of audio and/or visual data located within the description itself, without having to refer to a location external to the description" (page 7, last paragraph). As discussed in the rejection of claim 41 above, Pereira teaches a similar description scheme and therefore anticipated the claimed element.)

As per claim 46, Pereira teaches the digital file of claim 41 wherein "said data is binary" at page 6/1, 2nd paragraph (i.e., "digital" format).

6. **Claims 47-49 and 54 are rejected under 35 U.S.C. 102(a)** as being anticipated by "JPEG 2000 Image Coding System" Final Committee Draft Version 1.0, March 16, 2000, (supplied by Applicant in IDS, paper No. 6), hereinafter "IT-JPEG2000".

As per claim 47, IP-JPEG2000 teaches a digital file (see page 139, Fig. I-1) comprising:

- "a plurality of boxes containing data arranged in a manner consistent with the JPEG2000 specification and suitable to render an image" at page 139, Fig. I-1;
- "at least one of said boxes being at least one of a metadata box and a UUID box" at page 139, Fig. I-1, page 140, section I.4.5 and page 158, section 1.9.2;
- "including information within said at least one of said metadata box and said UUID box indicating the location of binary data, within said file and not within said

at least one of said metadata box and said UUID box, associated with said image" at page 158, sections I.9.2 and I.9.3.

(IT-JPEG2000 teaches that UUID boxes can be used to store binary data, and UUID Info boxes, which act as index for the UUID's in the file, contains a list of UUID's and specifies links (i.e., "location") to more information. UUID boxes and UUID Info boxes are distinct but within the JPEG2000 file.)

As per claim 48, IP-JPEG2000 teaches the digital file of claim 47 wherein "said information is in XML format" at page 157, section I.9.1.

As per claim 49, IP-JPEG2000 teaches the digital file of claim 47 wherein "said digital file is compliant with the JPEG2000 standard" at page 140, section I.4.6.

As per claim 54, IT-JPEG2000 teaches the digital file of claim 47 wherein "said information includes links to information external to said digital file" at page 159, section I.9.3.2.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. **Claims 1-40, 50-53 and 55-59** are rejected under 35 U.S.C. 103(a) as being unpatentable over **IT-JPEG2000** as applied to claims 47-49 and 54 above, and in view of Qian et al. (US 6,070,167), hereinafter "**Qian**".

As per claim 1, IT-JPEG2000 teaches a digital file (page 139, Fig. I-1) comprising:

- "a plurality of boxes containing data arranged in a manner consistent with the JPEG2000 specification and suitable to render an image" at page 139, Fig. I-1;
- "at least one of said boxes being a metadata box" at page 140 section I.4.5;

IT-JPEG2000 teaches the ability to add data to metadata boxes of a JPEG2000 file (section I.4.5) but does not explicitly teach: "including information within said metadata box describing the content of said image" as claimed. However, Qian teaches an analogous method that enable association of descriptive data to an JPEG2000

image to provide interactivity with said image at Col. 1 lines 59-67 and Col. 2 line 30-50.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine IT-JPEG2000 and Qian's teachings. Qian suggests adding descriptive data information to a JPEG2000 file in order to "utiliz[e] such information in content-based information retrieval, object-based editing and manipulation application" at Col. 2, lines 30-35 and Col. 4 lines 13-25.

As per claim 2, IT-JPEG2000 and Qian teach the digital file of claim 1 as discussed above. IT-JPEG2000 also teaches: "wherein said information is in XML format" at page 157, section I.9.1.

As per claim 3, IT-JPEG2000 and Qian teach the digital file of claim 1 as discussed above. IT-JPEG2000 also teaches: "wherein said digital file is compliant with the JPEG2000 standard" at page 140, section I.4.6.

As per claim 4, IT-JPEG2000 and Qian teach the digital file of claim 1 as discussed above. Qian also teaches: "wherein said information provides interactivity within said image" at Col. 4 lines 13-25.

As per claim 5, IT-JPEG2000 and Qian teach the digital file of claim 4 as discussed above. Qian also teaches: "wherein said interactivity includes providing a bounding region of a portion of said image" at Col. 2, lines 45-50.

As per claim 6, IT-JPEG2000 and Qian teach the digital file of claim 5 as discussed above. Qian also teaches: "wherein said bounding region is rectangular" at Col. 2 lines 39-40.

As per claim 7, IT-JPEG2000 and Qian teach the digital file of claim 5 as discussed above. Qian also teaches: "wherein additional information regarding said content is associated with said bounding region of said image" at Col. 5 lines 22-30.

As per claim 8, IT-JPEG2000 and Qian teach the digital file of claim 1 as discussed above. Qian also teaches: "wherein said information includes links to information external to said digital file" at Col. 2 lines 48-51.

As per claim 9 IT-JPEG2000 and Qian teach the digital file of claim 1 as discussed above. Qian also teaches: "wherein said information includes voice annotation" at Col. 5 line 24.

As per claim 10, IT-JPEG2000 and Qian teach the digital file of claim 1 as discussed above. Qian also teaches: "wherein said information includes object boundary information" at Col. 5 line 24.

As per claim 11, IT-JPEG2000 and Qian teach the digital file of claim 1 as discussed above. Qian also teaches: "wherein said information includes textual information regarding the content of said image free from copyright information" at Col. 5 lines 23-24 and Col. 6 lines 15-17.

As per claim 12, IT-JPEG2000 and Qian teach the digital file of claim 1 as discussed above. Qian also teaches: "wherein said information is MPEG-7 data" at Col. 5 lines 25-30.

As per claim 13, IT-JPEG2000 and Qian teach the digital file of claim 12 as discussed above. Qian also teaches: “wherein said MPEG-7 data is compliant with the MPEG-7 specification” at Col. 5 lines 25-29.

As per claim 14, IT-JPEG2000 and Qian teach the digital file of claim 12 as discussed above. Qian also teaches: “wherein said information includes binary data” at Col. 6 lines 1-20.

As per claim 15, IT-JPEG2000 teaches a digital file comprising:

- “a plurality of boxes containing data arranged in a manner consistent with the JPEG2000 specification and suitable to render an image” at page 139, Fig. I-1;
- “at least one of said boxes being a UUID box” at page 158, section I.9.2.

IT-JPEG2000 teaches the ability to add data to UUID boxes of a JPEG2000 file (section I.9.3) but does not explicitly teach: “including information within said UUID box describing the content of said image” as claimed. However, Qian teaches an analogous method that enable association of descriptive data to an JPEG2000 image to provide interactivity with said image at Col. 1 lines 59-67 and Col. 2 line 30-50. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine IT-JPEG2000 and Qian’s teachings because Qian suggests adding descriptive data information to a JPEG2000 file in order to “utiliz[e] such information in content-based information retrieval, object-based editing and manipulation application” at Col. 2, lines 30-35 and Col. 4 lines 13-25.

As per claim 16, IT-JPEG2000 and Qian teach the digital file of claim 15 as discussed above. IT-JPEG2000 also teaches: “wherein said information is in XML format” at page 157, section I.9.1.

As per claim 17, IT-JPEG2000 and Qian teach the digital file of claim 15 as discussed above. IT-JPEG2000 also teaches: “wherein said digital file is compliant with the JPEG2000 standard” at page 140, section I.4.6.

As per claim 18, IT-JPEG2000 and Qian teach the digital file of claim 15 as discussed above. Qian also teaches: “wherein said information provides interactivity with said image” at Col. 4 lines 13-25.

As per claim 19, IT-JPEG2000 and Qian teach the digital file of claim 18 as discussed above. Qian also teaches: “wherein said interactivity includes providing a bounding region of a portion of said image” at Col. 2 lines 45-50.

As per claim 20, IT-JPEG2000 and Qian teach the digital file of claim 19 as discussed above. Qian also teaches: “wherein said bounding region is rectangular” at Col. 2 lines 60-65.

As per claim 21, IT-JPEG2000 and Qian teach the digital file of claim 19 as discussed above. Qian also teaches: “wherein additional information regarding said content is associated with said bounding region of said image” at Col. 5 lines 22-30.

As per claim 22, IT-JPEG2000 and Qian teach the digital file of claim 15 as discussed above. Qian also teaches: "wherein said information includes links to information external to said JPEG2000 file" at Col. 2 lines 48-51.

As per claim 23, IT-JPEG2000 and Qian teach the digital file of claim 15 as discussed above. Qian also teaches: "wherein said information includes voice annotation" at Col. 5 line 24.

As per claim 24, IT-JPEG2000 and Qian teach the digital file of claim 15 as discussed above. Qian also teaches: "wherein said information includes object boundary information" at Col. 5 line 24.

As per claim 25, IT-JPEG2000 and Qian teach the digital file of claim 15 as discussed above. Qian also teaches: "wherein said information includes textual information regarding the content of said image free from copyright information" at Col. 6 lines 15-17.

As per claim 26, IT-JPEG2000 and Qian teach the digital file of claim 15 as discussed above. Qian also teaches: "wherein said information is MPEG-7 data" at Col. 5 lines 25-30.

As per claim 27, IT-JPEG2000 and Qian teach the digital file of claim 26 as discussed above. Qian also teaches: "wherein said MPEG-7 data is compliant with the MPEG-7 specification" at Col. 5 lines 25-29.

As per claim 28, IT-JPEG2000 and Qian teach the digital file of claim 26 as discussed above. Qian also teaches: "wherein said information includes binary data" at Col. 6 lines 1-20.

As per claim 29, IT-JPEG2000 teaches a digital file comprising:

- "a plurality of boxes containing data arranged in a manner consistent with the JPEG2000 specification and suitable to render an image" at page 139, Fig. I.1 and page 140, section I.4.6;

IT-JPEG2000 teaches the ability to add data to metadata boxes of a JPEG2000 file (section I.4.5) but does not explicitly teach: "at least one of said boxes containing MPEG-7 compliant description schemes" as claimed. However, Qian teaches an analogous method for adding data to an JPEG2000 image to provide interactivity with said image, wherein the data comprises MPEG-7 compliant description schemes at Col. 1 lines 59-67 and Col. 5 lines 22-30. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine IT-JPEG2000 and Qian's teachings. Qian suggests adding data information comprising MPEG-7 compliant description schemes to a JPEG2000 file because "By associating MPEG-7 descriptors to images, the images may be retrieved based on their graphical contents by advanced search engines. " at Col. 2, lines 30-35 and Col. 4 lines 13-25.

As per claim 30, IT-JPEG2000 and Qian teach the digital file of claim 29 as discussed above. IT-JPEG2000 also teaches: "further including information within at least one of a metadata box and a UUID box, wherein said information is in XML format"

at page 139, Fig. I-1 and page 157, section I.9.1. Qian also teaches: "information describing the content of said image" at Col. 5 lines 22-30.

As per claim 31, IT-JPEG2000 and Qian teach the digital file of claim 29 as discussed above. IT-JPEG2000 also teaches: "wherein said JPEG2000 file includes a metadata box" at page 140, section I.4.5.

As per claim 32, IT-JPEG2000 and Qian teach the digital file of claim 30 as discussed above. Qian also teaches: "wherein said information provides interactivity with said image" at Col. 4 lines 13-25.

As per claim 33, IT-JPEG2000 and Qian teach the digital file of claim 32 as discussed above. Qian also teaches: "wherein said interactivity includes providing a bounding region of a portion of said image" at Col. 2 lines 45-50.

As per claim 34, IT-JPEG2000 and Qian teach the digital file of claim 33 as discussed above. Qian also teaches: "wherein said bounding region is rectangular" at Col. 2 lines 60-65.

As per claim 35, IT-JPEG2000 and Qian teach the digital file of claim 33 as discussed above. Qian also teaches: "wherein additional information regarding said content is associated with said bounding region of said image" at Col. 5 lines 22-30.

As per claim 36, IT-JPEG2000 and Qian teach the digital file of claim 30 as discussed above. Qian also teaches: "wherein said information includes links to information external to said JPEG2000 file" at Col. 2 lines 48-51.

As per claim 37, IT-JPEG2000 and Qian teach the digital file of claim 30 as discussed above. Qian also teaches: "wherein said information includes voice annotation" at Col. 5 lines 24.

As per claim 38, IT-JPEG2000 and Qian teach the digital file of claim 30 as discussed above. Qian also teaches: "wherein said information includes object boundary information" at Col. 5 line 24.

As per claim 39, IT-JPEG2000 and Qian teach the digital file of claim 30 as discussed above. Qian also teaches: "wherein said information includes textual information regarding the content of said image free from copyright information" at Col. 5 lines 23-24 and Col. 6 lines 15-17.

As per claim 40, Col. 5 lines 23-24 and the digital file of claim 29 as discussed above. Qian also teaches: "wherein said MPEG-7 compliant description scheme includes binary data" at Col. 6 lines 18-21.

As per claim 50, IP-JPEG2000 teaches the digital file of claim 47 as discussed above. IT-JPEG2000 teaches the ability to add data to metadata or UUID boxes of a JPEG2000 file (section I.4.5) but does not explicitly teach: "said information provides interactivity with said image" as claimed. However, Qian teaches an analogous method that enable association of descriptive data to an JPEG2000 image to provide interactivity with said image at Col. 1 lines 59-67 and Col. 2 line 30-50. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine IT-JPEG2000 and Qian's teachings. Qian suggests adding descriptive

data information to a JPEG2000 file in order to "utiliz[e] such information in content-based information retrieval, object-based editing and manipulation application" at Col. 2, lines 30-35 and Col. 4 lines 13-25.

As per claim 51, IT-JPEG2000 and Qian teach the digital file of claim 50 as discussed above. Qian also teaches: "wherein said interactivity includes providing a bounding region of a portion of said image" at Col. 2 lines 45-50.

As per claim 52, IT-JPEG2000 and Qian teach the digital file of claim 51 as discussed above. Qian also teaches: "wherein said bounding region is rectangular" at Col. 2 lines 60-65.

As per claim 53, IT-JPEG2000 and Qian teach the digital file of claim 51 as discussed above. Qian also teaches: "wherein additional information regarding said content is associated with said bounding region of said image" at Col. 5 lines 22-30.

As per claim 55, IT-JPEG2000 teaches the digital file of claim 47 as discussed above. IT-JPEG200 teaches that binary data can be added using UUID boxes at page 158, section I.9.3, but does not explicitly teaches that "said binary data includes voice annotation" as claimed. However, Qian teaches an analogous method for adding data to an JPEG2000 image to provide interactivity with said image (Col. 2, lines 30-50), wherein the data includes voice annotation at Col. 1 lines 59-67. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine IT-JPEG2000 and Qian's teachings. Adding voice annotation to a JPEG2000

file as suggested by Qian will enhance user experiencing with the JPEG2000 file by providing sound output in addition to displaying only still image.

As per claim 56, IT-JPEG2000 teaches the digital file of claim 47 as discussed above. IT-JPEG200 teaches that binary data can be added to UUID boxes at page 158, section I.9.3, but does not explicitly teaches that “said binary data includes object boundary information” as claimed. However, Qian teaches an analogous method for adding data to an JPEG2000 image to provide interactivity with said, wherein the data includes object boundary information at Col. 2 lines 30-50. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine IT-JPEG2000 and Qian’s teachings. Qian suggests adding object boundary information to a JPEG2000 file in order to “utiliz[e] such information in content-based information retrieval, object-based editing and manipulation application” at Col. 2, lines 30-35 and Col. 4 lines 13-25.

As per claim 57, IT-JPEG2000 teaches the digital file of claim 47 as discussed above. IT-JPEG200 teaches that binary data can be added to UUID boxes at page 158, section I.9.3, but does not explicitly teaches that “said information includes textual information regarding the content of said image free from copyright information” as claimed. However, Qian teaches an analogous method for adding data to an JPEG2000 image to provide interactivity with said, wherein “the data includes textual information regarding the content of said image free from copyright information” at Col. 5 lines 22-30. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine IT-JPEG2000 and Qian’s teachings. Qian suggests

adding textual information to a JPEG2000 file in order to "utiliz[e] such information in content-based information retrieval, object-based editing and manipulation application" at Col. 2, lines 30-35 and Col. 4 lines 13-25.

As per claim 58, IT-JPEG2000 teaches the digital file of claim 47 as discussed above. IT-JPEG2000 teaches the ability to add data to metadata boxes of a JPEG2000 file (section I.4.5) but does not explicitly teach: "said information is MPEG-7 data" as claimed. However, Qian teaches an analogous method for adding data to an JPEG2000 image to provide interactivity with said image, wherein the data comprises MPEG-7 data at Col. 5 lines 25-28. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine IT-JPEG2000 and Qian's teachings. Qian suggests adding MPEG-7 data to a JPEG2000 file because "By associating MPEG-7 descriptors to images, the images may be retrieved based on their graphical contents by advanced search engines. " at Col. 2, lines 30-35 and Col. 4 lines 13-25.

As per claim 59, IT-JPEG2000 and Qian teach the digital file of claim 58 as discussed above. Qian also teaches: "wherein said MPEG-7 data is compliant with the MPEG-7 specification" at Col. 5 lines 25-30.

10. **Claims 43-45** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Pereira** as applied to claims 41-42 and 46 above, and in view of "MPEG-7 Multimedia Description Scheme, Description Definition language V 3.0, N3391", (supplied by Applicant in IDS, paper No. 6), hereinafter referred to as "**N3391**".

As per claim 43, Pereira teaches the digital file of claim 41 as discussed above.

Pereira does not explicitly teach: "said description scheme includes a choice of two different encoding scheme for data, namely, base16 and base64" as claimed. However, N3391 describes a MPEG-7 description scheme, which includes "choice of two different encoding scheme for data, namely base16 and base64" at page 11, section 6.2.4.7. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to employ the encoding scheme as taught in N3391 into Pereira's description scheme because N3391 represents the International Standard for MPEG-7 description scheme. Using the encoding scheme as suggested by N3391 will ensure that the description scheme will be compliant with the standard, and therefore compatible with all applications implemented based on the standard.

As per claim 44, Pereira and N3391 teach the digital file of claim 43 as discussed above. N3391 also teaches: "said base16 is part of an element name MediaData16" at page 11, section 6.2.4.7.

As per claim 45, Pereira and N3391 teach the digital file of claim 43 as discussed above. N3391 also teaches: "said base64 is part of an element name MediaData64" at page 11, section 6.2.4.7.

Response to Arguments

11. Applicant's arguments filed June 9, 2005 have been fully considered but they are not persuasive. The examiner respectfully traverses applicant's arguments.

Regarding the 35 U.S.C 101 rejection to claims 1-59, applicant argued that digital files are statutory subject matter because “digital files are copyrightable subject matter”. The examiner respectfully submits that copyrightable is different from patentable.

Claims 1-59 are directed to “a digital file”, and the bodies of the claims recite only nonfunctional descriptive material. Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material”. In this context, “functional descriptive material” consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of “data structure” is “a physical or logical relationship among data elements, designed to support specific data manipulation functions.” The New IEEE Standard Dictionary of Electrical and Electronic Terms 308 (5th ed. 1993).). “Nonfunctional descriptive material” includes, but is not limited to music, literary works, and compilation or **mere arrangement of data**. Both type of “descriptive material” are nonstatutory when claimed as descriptive material per se. Warmerdam, 33 F. 3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Claims 1-59 are directed to nonfunctional descriptive material per se and therefore nonstatutory.

Regarding claims 41-42 and 46, applicant argued that Pereira’s MPEG-7 description scheme does not include “data for rendering said at least one of said audio

and visual media". On the contrary, Pereira teaches at page 6/2 that "the description information is associated with the content while that content is being capture", wherein the content includes audio and video data (bottom of page 6/1). Pereira also teaches "MPEG-7 descriptions may be physically co-located with the "reproduction data", in the same data stream", wherein the "reproduction data" corresponds to data for rendering said audio and visual media as claimed.

12. **Regarding claims 47-49 and 54**, applicant argued that IT-JPEG2000 does not teach "at least one of said metadata box and a UUID box" because the UUID boxes taught the IT-JPEG2000 reference are different from the claimed UUID box. The examiner respectfully notes that the features upon which applicant relies (i.e., "the UUID box disclosed by the IT-JPEG2000 reference contains no information as to the location of data outside the UUID box") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

13. **Regarding the 35 U.S.C 103 based upon Pereira and Qian**, applicant attempted to disqualify the Qian reference by submitting the declaration with the statement that the application and the reference were, at the time the invention was made, owned by a common assignee. However, the declaration is insufficient to disqualify the Qian reference because Qian is a prior art under 35 U.S.C 102(a), and the 35 U.S.C 103(c) exclusion only applies to prior which only qualifies under 35 U.S.C 102(e), (f) or (g). Prior art under 35 USC 102(a) or (b) can't be overcome by establishing

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common ownership at the time of the invention. Since Qian is a proper prior art, the 35 USC 103 rejections based upon Pereira and Qian are proper and should be maintained.

In view of the above argument, the 35 U.S.C 102 and 103 rejections are hereby sustained.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

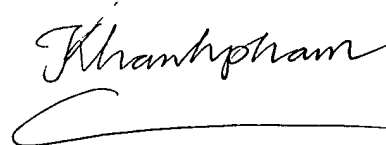
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh B. Pham whose telephone number is (571) 272-4116. The examiner can normally be reached on Monday through Friday 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on (571) 272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Khanh B. Pham
Examiner
Art Unit 2166

December 28, 2005

A handwritten signature in cursive script, reading "Khanh B. Pham", with a long horizontal flourish underneath.